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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,431	12/08/2003	James J. Miller	Miller-001:CIP	2329
21897	7590	06/29/2006	EXAMINER	
THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057			ROWAN, KURT C	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/730,431
Filing Date: December 08, 2003
Appellant(s): MILLER ET AL.

Taras Bemko
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 7, 2006 appealing from the Office action mailed Feb. 24, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is not correct since applicant has submitted claims for an amendment that was not entered after Final Rejection. For a correct copy of the claims see the claims filed November 29, 2004.

(8) Evidence Relied Upon

1638923	DANIELSON	8/1927
2748521	SCHAEFER	6/1956

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielson over Schaefer.

(10) Response to Argument

Applicant argues that Danielson that the post or pin is not part of the hook and that the claims recite a "catch, integral to the first shank" and that Danielson relies on three catches. First, applicant has used the term "comprising" in constructing the claims and second, the rejection relies on the catch of Danielson being replaced by the catch of Schaefer. However, reciting a catch, integral to the first shank does not limit the claim to one catch, since there merely has to be at least a catch integral to the first shank which is shown by Schaefer.

Applicant further argues how the hook functions, but all the claims present in the current invention are article/apparatus claims. Schaefer discusses how the trap hook

functions in column 1, lines 65-68 and no mention is made of any pulling force exerted by the fish, but that a lateral force exerted to the hooks to disengage the interlocking means is effected by the fish. When a fish bites, the main force is exerted by the jaws closing which is the two opposing forces of the jaws being closed on the prey by the fish. So the device of Schaefer and Danielson for that matter would also inherently experience those forces as a fish strikes the bait. Also, Schaefer shows that the catches 6,6 are bent or curved about the width of the coil spring.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art. In response to applicant's argument that the release mechanism of Schaefer can not be physically incorporated into the Danielson device, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that Danielson is nonanalogous to the present invention because the post or pin 7 is separate from the hooks, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Danielson is in applicant's field of endeavor since both Danielson and the present invention are fishing hooks.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KR


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Conferees:

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